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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/700,996	11/04/2003	Frank Breme	034183/268724	5622

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EXAMINER

VERSTEEG, STEVEN H

ART UNIT	PAPER NUMBER
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1753

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/700,996	Applicant(s) BREME, FRANK	
	Examiner Steven H VerSteeg	Art Unit 1753	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-12 and 15-19 is/are allowed.
- 6) ☒ Claim(s) 13 and 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 13 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,427,671 to Ahmed.

3. For claim 13, Applicant requires an apparatus for producing an optical element comprising a substrate having a first side and a generally parallel second side and at least one optically effective system of layers on a substrate comprising an evacuable sputter chamber and a substrate holder with receiving elements for substrates with each receiving element being mounted so that each substrate can be rotated both about a turning axis that is oriented substantially parallel to the substrate sides and about an axis of rotation that is oriented substantially perpendicularly to the substrate sides.

4. Ahmed discloses a UVP apparatus (abstract) comprising an evacuable sputtering chamber **10** with a substrate holder **20** that rotates (col. 4, l. 48-49) and rotates the substrates individually (col. 4, l. 56-58).

5. For claim 14, Applicant requires a common drive for the rotary movement and the turning movement. Ahmed discloses a common motor drive **18** for the turning and rotary movements.

Response to Amendment

6. The claim objection presented in the office action mailed May 19, 2004 is withdrawn in light of the amendment.
7. The 112-second paragraph rejections presented in the office action mailed May 19, 2004 are withdrawn in light of the amendment.
8. The 102(b) rejection of claims 1-3 over US 6,143,143 to Walls et al. (Walls) presented in the office action mailed May 19, 2004 is withdrawn in light of the amendment.
9. The 102(b) rejection of claims 13 and 14 over Ahmed presented in the office action mailed May 19, 2004 stands.
10. The 103(a) rejection of claim 10 over Walls presented in the office action mailed May 19, 2004 is withdrawn in light of the amendment.

Allowable Subject Matter

11. Claims 1-12 and 15-19 are allowed.
12. The following is a statement of reasons for the indication of allowable subject matter: it is neither anticipated nor obvious over the prior art of record to have a method for producing an optical element comprising a substrate having a first side and a second side and at least one optically effective system of layers on the substrate as claimed by Applicant in claim 1.
13. Walls deposits the protective layer on the second side, but the protective layer is only present while the layers are formed on the first side. After the layers are all formed, Walls removes the protective layer (col. 2, l. 39-42; col. 2, l. 47-50; col. 3, l. 50-57). Modifying Walls to keep the protective layer as claimed by Applicant would require hindsight.

Response to Arguments

14. Applicant's arguments filed August 19, 2004 have been fully considered but they are not persuasive.

15. Applicant has argued that Ahmed does not disclose that the receiving elements are rotated about a turning axis running substantially parallel to the substrate sides. I disagree.

Ahmed discloses that the "individual segments may be rotatable so as to bring the other sides of the lenses into downwardly facing position" (col. 4, l. 56-58). In order to rotate the lenses so that the other side is facing downward, it is inherent that the turning axis is substantially parallel to the sides of the elements.

General Information

For general status inquiries on applications not having received a first action on the merits, please contact the Technology Center 1700 receptionist at (571) 272-1700.

For inquiries involving Recovery of lost papers & cases, sending out missing papers, resetting shortened statutory periods, or for restarting the shortened statutory period for response, please contact Denis Boyd at (571) 272-0992.

For general inquiries such as fees, hours of operation, and employee location, please contact the Technology Center 1700 receptionist at (571) 272-1300.

Conclusion

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**


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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven H VerSteeg whose telephone number is (571) 272-1348. The examiner can normally be reached on Mon - Thurs (6:30 AM - 5:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam X Nguyen can be reached on (571) 272-1342. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Steven H VerSteeg
Primary Examiner
Art Unit 1753

shv
September 7, 2004